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Edward R. diGirolamo

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COATS & BENNETT, PLLC
1400 Crescent Green, Suite 300
Cary, NC 27518

EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD R. DIGIROLAMO and
MICHAEL TORRES

Appeal 2010-006408
Application 10/682,586
Technology Center 3600

Before LINDA E. HORNER, STEVEN D.A. McCARTHY and
GAY ANN SPAHN, *Administrative Patent Judges*.

McCARTHY, *Administrative Patent Judge*.

DECISION ON APPEAL

1 The Appellants¹ appeal under 35 U.S.C. § 134 from the Examiner's
2 decision rejecting claims 1, 6-8, 11, 21-24 and 34-38, at least one of which is
3 twice-rejected. Claims 2-5, 9, 10, 12-20 and 25-33 are cancelled. We have
4 jurisdiction under 35 U.S.C. § 6(b).

¹ The Appellants identify the real party in interest as The Steel
Network, Inc.

We sustain the rejection of claims 21-24 and 34-38 under 35 U.S.C. § 102(b) as anticipated by Vukmanic (US 4,677,802, issued Jul. 7, 1987).

We do not sustain the rejection of claims 1, 6-8 and 11 under 35 U.S.C. § 102(b) as anticipated by Laughlin (US 5,619,263, issued Apr. 8, 1997).

Rejection of Claims 21-24 and 34-38 as Anticipated by Vukmanic

The Appellants do not argue the rejection of any of claims 21-24 and 34-38 separately from the rejections of the others. Claim 21 is representative:

21. A stud spacer for extending between two studs comprising:

a main member adapted to extend between the two studs;
the main member including first and second end portions;
a projection extending from one end portion;
a projection receiver formed on the other end portion;
and

wherein either the projection or projection receiver includes one or more locking members such that when a projection of one stud spacer is projected into the projection receiver of another stud spacer a locked condition is realized.

The Appellants contend that the Examiner misconstrued the terms “stud” and “stud spacer” (*see, e.g.*, App. Br. 8); and that Vukmanic fails to describe a “stud spacer” as properly construed (*See* App. Br. 9-11). The Examiner correctly interpreted representative claim 21 in an office action during the prosecution of the underlying application, however:

As set forth, the claims are to a stud spacer and its specific structures, not a wall or a stud. The reference Vukmanic shows the stud spacer with its

specific structures as claimed, and able to function as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art is capable of performing the intended use, then it meets the claim.

(Final Office Action mailed Jan. 10, 2007, at 4.)

The Appellants do not appear to contest the Examiner's finding that the cross-member or runner 12 described by Vukmanic includes each structural limitation recited in the body of representative claim 21. Neither do the Appellants appear to contest the Examiner's finding that Vukmanic's cross-member or runner 12 is capable of performing the functional limitations recited in claim 21. (*See generally* App. Br. 11-12.) Therefore, we adopt and incorporate by reference the Examiner's findings at page 3, line 11 (starting with "Vukmanic shows . . .") through page 4, line 7 of the Answer (ending with ". . . and the hold down element."). We specifically find that Vukmanic's cross-member or runner 12 includes each structural limitation in the body of claim 21 and that the cross-member or runner 12 is capable of performing the recited functional limitations.

In light of this finding, the Examiner's interpretation of the term "stud spacer" is sufficient to reject claims 21-24 and 34-38. The Appellants cite a definition of a "spacer" as a "device for holding two members at a given distance from each other." (App. Br. 10, citing MCGRAW-HILL DICTIONARY OF SCIENTIFIC & TECHNICAL TERMS (5th ed. 1994).) Adopting the Appellants' definition, a "stud spacer" is a device intended to be used for holding two studs at a given distance from each other. Thus the recitation of a "stud spacer" in representative claim 21 merely identifies an intended use

1 of a structure meeting limitations fully defined in the body of the claim.
2 (Ans. 5; Final Office Action mailed Jan. 10, 2007, at 4-5.)

3 “[I]t is well settled that the recitation of a new intended use for an old
4 product does not make a claim to that old product patentable.” *In re*
5 *Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citation omitted). The
6 Appellants provide no persuasive evidence or reason why the structure
7 described by Vukmanic, which is structurally identical to the structure
8 recited in claim 21, might not be susceptible of use as a stud spacer. (*See*
9 *generally* App. Br. 11-12.) *See also In re Best*, 562 F.2d 1252, 1255
10 (CCPA 1977) (citations omitted). Therefore, the Examiner’s identification
11 of the term “stud spacer” as a statement of intended use during prosecution
12 provided the Appellants sufficient notice to allow the Appellants to
13 recognize and seek to counter the grounds of rejection. *See In re Jung*, 637
14 F.3d 1356, 1362 (Fed. Cir. 2011)(citing *Chester v. Miller*, 906 F.2d 1574,
15 1578 (Fed. Cir. 1990)).

16 Since the Appellants offer no persuasive evidence or reason why the
17 structure described by Vukmanic might not be susceptible of use as a stud
18 spacer, the Examiner correctly finds that Vukmanic describes a stud spacer.
19 *See Schreiber*, at 1478-79 (upholding the Board’s affirmance of a rejection
20 under section 102(b) on the basis of a finding that a device disclosed in a
21 prior art reference was capable of performing a function which the appellant
22 alleged to distinguish the apparatus from the device). While the Appellants
23 argue that “[t]he term ‘stud spacer’ is a term of art widely used to describe a
24 structural component of a wall,” (App. Br. 12), the Appellants do not
25 provide convincing arguments or evidence to show that such an art-
26 recognized stud spacer differs structurally from the structure disclosed in

Vukmanic. Therefore, the Examiner correctly found that Vukmanic describes a structure including each and every limitation of claim 21. We sustain the rejection of claims 21-24 and 34-38 under § 102(b) as anticipated by Vukmanic.

Rejection of Claims 1, 6-8 and 11 as Anticipated by Laughlin

Claims 6-8 and 11 depend from claim 1. Claim 1 recites “wherein the stud spacer is adapted to be connected to another stud spacer by extending the projection of the one stud spacer through the opening within the one stud and into the opening of another stud spacer.”

Laughlin describes a strut 50. Laughlin discloses that

The ends of the strut are formed into Tee bar stem gripping fingers which are adapted to grip the stem of the Tee bar on opposite sides of an enlarged or bulb head. Each end includes a central downwardly bent finger seen at 64 and 65, and also a downwardly bent U-shaped surrounding finger seen at 66 and 67. . . . The central fingers 64 and 65 include inwardly angled edge barbs 72 and 73, adapted to bite into the far side of the stem of a Tee below the enlarged head of the Tee.

(Laughlin, col. 4, ll. 39-50.) The Examiner finds that downwardly bent finger 64 or 65 corresponds to the “projection” recited in claim 1. The Examiner further finds that space between a U-shaped surrounding finger 66 or 67 and an enclosed, downwardly bent finger 64 or 65 corresponds to the “opening” in the stud spacer recited in claim 1.

The Examiner’s technical reasoning does not adequately convey that the Examiner has a sound basis for belief that Laughlin’s strut 50 necessarily is capable of performing the function recited in the final “wherein” clause of claim 1. (Ans. 5-6.) In particular, the Examiner’s reasoning does not adequately address whether Laughlin’s downwardly bent finger 64 or 65 is

1 necessarily capable of extending both through an opening in one stud and
2 into an opening in another strut 50. (*See* App. Br. 18.) Since the strut 50 as
3 described by Laughlin does not necessarily include each and every limitation
4 of claim 1, we do not sustain the rejection of claims 1, 6-8 and 11 under
5 § 102(b) as anticipated by Laughlin.

6 DECISION

7 We AFFIRM the rejection of claims 21-24 and 34-38.

8 We REVERSE the rejection of claims 1, 6-8 and 11.

9 No time period for taking any subsequent action in connection with
10 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
11 § 1.136(a)(1)(iv).

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13 AFFIRMED-IN-PART

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